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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,522	06/04/2001	Richard E. Scordato	M1005/7006 RJK	3542
26453	7590	12/14/2005	EXAMINER	
BAKER & MCKENZIE LLP 805 THIRD AVENUE - 29TH FLOOR NEW YORK, NY 10022			GORDON, BRIAN R	
			ART UNIT	PAPER NUMBER
			1743	
DATE MAILED: 12/14/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/873,522

Applicant(s)

SCORDATO ET AL.

Examiner

Brian R. Gordon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 12-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 12-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-8 and 12-77 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Interpretations***

2. As previously stated the clause "shaped to fit in an operator's hand" does not require any specific shape but only means the device is capable of being held in a hand as implied by the preamble. The clause "operable by a thumb of an operator" does not require any specific structure. The clause expresses how applicant intends for the device to be operated. The button of the device can be operated by any finger or pressed by any means as desired by the operator.

As to those claims that are directed to the manner in which the device is used (such as claim 4) the examiner asserts one may use the devices of the instant invention as well as the prior art as one so desires.

As to the phrase "ergonomically shaped", this term does not imply nor specify any particular or defined shape. Applicant has not defined the term as consisting of any particular shape. What may be considered ergonomic for one person may not be ergonomic for the next. Therefore, such a recitation and others which are directed to use of the term do not further structurally limit the device.

Those claims which are directed to how the device is held and positioned in an operator's hand is intended use and does not further limit the structure. One can

choose to hold any device including the one of the instant applicant in manner which one desires.

As to claims 25 and 32-37, the preamble should be amended to recite operable for aspirating and dispensing fluid through a nozzle. In a dispenser such as that Ho et al. the liquid is aspirated from the container up through the tube 51 to be dispensed. As such to distinguish the aspiration, the claims should be further amended as such.

Claim 31 (and other claims directed to the same principle, for example claim 41) recites narrative language that moreso expresses a process limitation of how a tip is mounted. The tip is not positively claimed as an element. Furthermore, how one intends for a tip to mounted and used with the device is not considered further limiting of the structure.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 17, the examiner indicated it was unclear if applicant intended to claim the pipette tip as an element of the invention. While applicant has specified the nozzle as being positively claimed, the pipette tip is not considered an element of the invention. The phrase "operable for receiving a pipette tip" does not constitute a positive claim to requiring the pipette tip be an element of the invention. The phrase

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expresses the ability of the nozzle to be able to receive a tip. The remainder of the claim is also directed to describing elements of the invention with respect to the unclaimed tip. Line 3, of the claim recites "said tip affixed to said nozzle". There is no antecedent basis within the claim for such a tip. A positive claim to the tip is required. The claim should be amended to recite said nozzle comprising a pipette tip attached thereto.

It appears as if the same comments would also apply to claim 70 and other claim which mentions a pipette tip in a secondary reference to describing other elements of the device.

While claim 22 (and the other claims directed to such) is not considered to be further structurally limiting, it is unclear how the pressure one exerts on the device cannot exceed 14 psi. (atmospheric pressure). When present in an ambient environment any attempt to pickup or hold the pipette would result in the application of pressure greater than that exerted on the device by that of the environment alone.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2, 4-5, 12-13, 15-24, 30-31, 36, 38-41, 45-46, 47-52, 54-58, 60-61, 65-66, 68-72, and 74-77 are rejected under 35 U.S.C. 102(b) as being anticipated by Clifford US 3,246,559.

Clifford discloses a pipetting device with an angled nozzle 64. The device is capable of aspirating and dispensing fluid into and from a cuvette 25 (as described in column 4, lines 31-49).

As seen in the figures, there is button centrally located on the head.

The holder 11 and head member 12 (including the button) are removable from one another.

The head member may be considered an adapter for when attached it changes the size of the device.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
10. Claims 3, 6-8, 25-29, 32-35, 42-44, and 62-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clifford as applied to claims 1-2, 4-5, 12-13, 15-24, 30-31, 36, 38-41, 45-46, 47-52, 54-58, 60-61, 65-66, 68-72, and 74-77 above, and further in view of Math US 2,796,204.

Math discloses the combination of a dispensing device 10 attached to a bottle 12 (bottle or bottom portion removable). As seen in the figures the device is capable of being held in one's hand and operated (via button or tab 36 substantially near the central axis) to dispense or aspirate a liquid via spout 28.

The examiner asserts that the handle element 37 may be considered a hook or the spring element 42 (as seen in the figure). The degree of the bend in the spring/hook 42 depends upon how far the tab/button 36 is depressed. The spring/hook is removable/replaceable via a screw (not labeled) and or collar 40.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Clifford to include a hook element such as that of Math in order to provide a means for holding and carrying the device.

11. Claims 14, 47, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clifford as applied to claims 1-2, 4-5, 12-13, 15-24, 30-31, 36, 38-41, 45-46, 47-52, 54-58, 60-61, 65-66, 68-72, and 74-77 above, and further in view of Kelly et al. US 6,737,023.

Clifford does not disclose the device as comprising a mechanism for ejecting tip 19.

Kelly et al. discloses air displacement pipettes including a novel mounting shaft and a unique pipette tip tailored to the mounting shaft such that the tip is easily insertable by a pipette user onto the shaft to a fluid tight position in which the tip is secured against undesired lateral rocking on or displacement from the shaft and, after use, is easily ejectable from the shaft by the pipette user; such tip insertion and ejection requiring the pipette user to only exert axial tip insertion and ejection forces of about one pound or less thereby substantially eliminating all risk of repetitive motion injury to the pipette user.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Clifford to incorporate the tip ejection mechanism as taught by Kelly et al. in order to remove and replace the tip 19 with minimal risk of injury to the user.



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12. Claims 20, 37, 53, and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clifford as applied to claims 1, 30, and 31 above, and further in view of Strandberg et al. US 5983733.

Clifford does not disclose the inventions as comprising a padding material.

Strandberg et al. discloses a hand-held pipette comprising, in combination: a hand receiving portion having an ergonomic contour, a combination fluid inlet and outlet located adjacent the hand portion, means for introducing and dispensing fluid into and out of the pipette via the inlet and outlet, and a resilient cushion disposed along an outer periphery of the hand receiving portion to reduce fatigue and trauma to a technician operating the pipette.

It would have been obvious to one of ordinary skill at the time of the invention to modify either of the devices of Clifford to incorporate the cushion or padding as taught by Strandberg in order to relieve or reduce fatigue to an operators hand when holding the devices.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Goldberg, Hicks, and Tietje et al. disclose pipette dispensing and aspirating devices.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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